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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,638	10/29/2003	Hisashi Kuroshima	17154	5491
23389 7590 10/15/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER CONLEY, SEAN EVERETT	
			ART UNIT 1797	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/696,638	Applicant(s) KUROSHIMA ET AL.	
	Examiner Sean E. Conley	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007 and 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-35 is/are pending in the application.
- 4a) Of the above claim(s) 27-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-26 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/22/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

Response to Amendment

1. The amendment filed July 19, 2007 has been received and considered for examination. Claims 1-6 have been canceled and new claim 35 has been added. Claims 7-35 are pending with claims 27-34 remaining withdrawn from consideration for being directed to a non-elected species. In response to the amendments of claims 18-21, the rejections under 35 U.S.C. 112, second paragraph, have been withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7-10, 14-16, 21-23, 25-26 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Hearne (U.S. Patent No. 5,069,273).

Regarding claims 21, 25 and 35, O'Hearne discloses a device comprising: a cooling holding unit (refrigerated compartment (26)) capable of holding and cooling sterilized equipment which has been sterilized by hot steam; a drying holding (heated compartment (24)) unit capable of holding and drying the sterilized equipment, and a storage unit (storage compartment (29)) capable holding and storing the sterilized

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equipment. The cooling unit, drying unit, and storage unit are all contained in a common unit (cabinet (22)) (see figures 1-2; see col. 2, line 43 to col. 67).

Furthermore, the cooling holding unit (refrigerated compartment (26)) is capable of being arranged, via wheels (108, 110), near a steam sterilization device for sterilizing medical equipment.

Regarding claims 7-10, 22 and 26, O'Hearne discloses a cooling holding unit (26) comprising containers (trays (102)) that are inserted into racks (100). Furthermore, the trays (102) inserted into racks (100) have sidewalls which are the positioning portions that are capable of generally positioning the sterilized equipment such as endoscopes which are to be held therein (see figure 4; see col. 5, lines 52-59). As shown in figure 4, the trays (102) contain lowered positioning portions formed by the sidewalls and the bottom of the tray, wherein the sterilized equipment such as endoscopes can be held and arranged to fit the shape of the tray.

Regarding claim 23, O'Hearne discloses a drying holding unit (24) which has containers (trays (70)) capable of storing the sterilized equipment (see figure 6; see col. 4, lines 65-68).

Regarding claims 14-16, O'Hearne discloses that the storage unit, cooling unit and drying unit are all capable of being opened and closed by means of a door. Specifically, all compartments (24, 26, and 29) of the cabinet (22) are opened and closed by doors (see figures 1 and 2; see col. 5, lines 30-40; see col. 3, lines 20-30).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hearne.

O'Hearne discloses a cooling section (compartment (24)) having a fan (54) and a plurality of removable trays (70) which contain a plurality of apertures (76) forming a mesh that enable circulation of the cold air around the items contained in the tray (see figure 7; see col. 2, lines 59-64; see col. 4, line 65 to col. 5, line 17). O'Hearne only discloses a single fan and does not explicitly teach the use of a pair of fans. However, in view of the legal precedent established by the prior case law *St. Regis Paper Co. V. Bemis Co., Inc.* 193 USPQ 8, 11 (7th Cir. 1977) which states that duplication of parts for a multiplied effect has no patentable significance, it would have been well within the purview and obvious to one of ordinary skill in the art at the time the invention was made to provide another fan on the cooling unit for enhancing the cool air circulation by further including additional fans.

6. Claims 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hearne as applied to claim 21 above, and further in view of Northrop et al. (U.S. Patent No. 6,619,768 B1).

O'Hearne disclose a food serving cart having a storage compartment (29) for storing dishes and utensils (see col. 2, lines 67-68). However, O'Hearne fails to explicitly disclose a storage compartment having a storage container or being sectioned into storage areas according to the size of the items being stored.

Northrop et al. disclose a portable storage container for carrying plates, dishes and utensils, wherein the container is sectioned into compartments according to the size of the items being stored (see figure 6). Northrop et al. disclose that such a container

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solves the problem of the burden that arises when trying to carry or transport a large number of dishes and utensils which are usually grouped together in a variety of bags, containers, or boxes (see col. 1, lines 15-22; see col. 4, lines 15-38).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of O'Hearne and include a storage container in the storage compartment or section the storage area into compartments according to the size of the items being stored as exemplified by Northrop et al. in order to organize and more easily transport the dishes and utensils.

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hearne as applied to claim 22 above, and further in view of Jacobs (U.S. Patent No. 3,914,957).

O'Hearne discloses the claimed invention except for a cooling unit (refrigeration section) having containers capable of storing sterilized equipment which comprise detachable cooling members having cooling means wherein the cooling members are lids for covering the containers.

Jacobs discloses a fast cooling liquid dispensing container for use in a refrigerator (see col. 1, lines 4-10). The cooling liquid dispensing container is a container (38) that includes a lid (40), wherein the lid (40) has a tunnel or passage (68) so that the container receives the cool air from the evaporator of the refrigeration system (see figures 1-2; see col. 3, lines 17-52). Thus the passage (68) in the lid is the

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cooling means for providing fast cooling to the items stored in the container (38). The container (38) is capable of storing sterilized equipment.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cooling unit of O'Hearne and include containers having cooling members that are lids as exemplified by Jacobs in order to provide fast cooling of the items stored in the containers.

Response to Arguments

8. Applicant's arguments, see pages 8-10, filed July 19, 2007, with regards to the rejection of claims as being anticipated by O'Hearne have been fully considered but they are not persuasive.

First, claims 1-6 have been canceled and the rejections pertaining to these claims are therefore moot.

Regarding claim 21, the Applicant's arguments are not commensurate in scope with the claims. The Applicant's arguments are directed to an intended use of the device disclosed by O'Hearne. Specifically, the Applicant argues that O'Hearne discloses a device that heats and cools food and the storage unit disclosed is for storing something other than food (utensils). However this argument is not persuasive since it is directed to the intended use of the device. The device disclosed by the prior art needs to only be capable of performing the intended use claimed by the Applicant. As for claim 21, the prior art device of O'Hearne anticipates all of the claimed structural limitations and is capable of performing the claimed intended use. The remaining

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dependent claims (claims 7-19 and 22-26) are rejected as indicated in the above rejections. New claim 35 has also been rejected as being anticipated by O'Hearne.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Conley whose telephone number is 571-272-8414. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEC



October 3, 2007



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